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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/073,598

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Nicole Beaulieu

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5942

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03/12/2009

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EXAMINER

MOSSER, ROBERT E

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

03/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/073,598	Applicant(s) BEAULIEU, NICOLE	
	Examiner ROBERT MOSSER	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-12,14,15,18-22,33,35,36,39-41,43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7-12,14,15,18-22,33,35,36,39-41,43 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1, 3, 7-9, 12, 14, 18-20, 33, 35, 39-41**, and **43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178 and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), and Bennett '178 teach the above listed claimed features as

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determined by the Patent Board Appeals in the decision rendered March 10th, 2008 incorporated herein by reference however the Board decision is silent regarding the newly amended features directed *to the automated selection being made according to the rules of the game being played and according to a strategy to optimize the likelihood that said person will receive a value payout.*

The above presented feature however is taught by the reference of Joshi (Figure 7, Col 8:56-9:18). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the optimized auto-selection feature of Joshi into the combination of Bennett '102 , Appellant's Admitted Prior Art , and Bennett '178 in order to enable the player to select a default selection of the Applicant's admitted prior art without sacrificing optimal game actions.

Claims **4, 15, 36, and 44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, Mayeroff, and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, and Mayeroff teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10th, 2008 incorporated herein by reference.

Claims **10-11**, and **21-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, Walker and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, and Walker teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10th, 2008 incorporated herein by reference.

Response to Arguments

Applicant's arguments filed December 30th, 2008 have been fully considered but they are not persuasive.

The applicant commences their arguments on page 10 of their remarks by arguing proposed criteria for the proper establishment of obviousness. Specifically the applicant argues the following elements in combination must be present:

(a) The prior art must provide one of ordinary skill in the art with a suggestion or motivation to modify or combine the teachings of the references relied upon in rejecting the claims;

(b) The prior art must provide one of ordinary skill in the art with a reasonable expectation of success; and

(c) the prior art, either alone or in combination, must teach each and every limitation of the claimed invention.

These elements in combination are not reflective of the requirements for the establishment of a prima facie case of obviousness as set forth by MPEP 2141 -2143.

Continuing onward the applicant argues that the claimed invention calls for a controller programmed to respond to a player request by making an automated selection of player selectable elements wherein the selection as provided is made both in accordance with the rules of game play and in a strategy to optimize the likelihood that a person will receive a payout.

While conceding that the prior art of Joshi teaches the identification of player selectable selections (applicant's remarks page 11) and that the applicant admitted prior art teaches the automated selection of game selectable selections responsive to a player request, the applicant contends that the two references could not be bodily incorporated into one another.

In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant's arguments that the modification of Joshi to include the automated selection of selections indicated by Joshi according to the rules of game play, a strategy to optimize the likelihood that a person will receive a payout is non-persuasive because

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the applicant has not provided a basis or rational as to why this modification would be a destructive modification of the base reference of Bennett '102. Further even in the case wherein the merit of the modification were measured solely between the applicant's admitted prior art of Keno teachings and the teachings of Joshi, the applicant's arguments do not present how the optimal strategy presented by Joshi and the applicant admitted prior art system would teach away from one another by a characterization of these teaching as the antithesis of one another. It is further noted that present a combination of elements that would not be exclusive to one another as an optimal strategy would reasonably include a random selection method depending on game environment.

Based on the above, the rejection of record is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art
Unit 3714

/R. M./
Examiner, Art Unit 3714

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